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| EXAMINER |
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CUTLIFF, YATE KAI RENE

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| ART UNIT | PAPER NUMBER |
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1621

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| NOTIFICATION DATE | DELIVERY MODE |
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10/29/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

| | | | |
|------------------------------|--------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 10/558,156 | Applicant(s) SAWADA ET AL. | |
| | Examiner YATE' K. CUTLIFF | Art Unit 1621 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9-13 is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-8 is/are rejected.
- 7) ☒ Claim(s) 5 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>11/23/2005 & 2/23/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. Claims 1 - 13 are pending.
Claims 1 – 4 and 6 - 8 are rejected.
Claim 5 is objected.
Claims 9 - 13 are allowed.

Oath/Declaration

2. The Oath/Declaration submitted December 13, 2006 is not legible or is not in permanent ink, or its equivalent in quality, as required under 37 CFR 1.52(a)(1)(iv).
Applicant is required to submit a new Oath/Declaration.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-4 and 6-8 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. According to page 6, paragraph 2, the step of regulating the water content of the reaction system is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). This section of the specification is a clear indication that Applicant was only able to achieve the desired monoglyceride-containing composition by regulating the amount of water such that the

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amount is maintained in a amount between 500 to 5000 ppm. Further, it is noted that regulating the water content is an essential feature of claim 9.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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8. Claims 1-4 and 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Voegeli (US 2,628,967).

9. The rejected claims cover, inter alia, a process for producing a monoglyceride-containing composition, comprising the step of reacting glycerin with at least one kind of an acyl-containing compound selected from the group consisting of a fatty acid and a glycerin ester, using a catalyst comprising at least one metal selected from the group consisting of iron, cobalt and manganese in an amount of 0.1 to 60 ppm in terms of metal as a weight ratio thereof to the total weight of the glycerin and the acyl-containing compound.

The dependent claims further limit the processing steps, identify the reactants and identify the percentage of product produced by the process.

10. Voegeli discloses a process for the production of monoglycerides and diglycerides wherein process favors the production of monoglycerides and the level of monoglycerides is the chief product at levels of 90% or more. (see col. 1, lines 5-7, lines 34-37 & Examples 1 & 2). Further, the reactants of Voegeli are fatty acids and polyhydric alcohols, with the catalyst can be selected from the metals of iron, manganese and cobalt. (see col. 2, lines 37-39 & col. 1, lines 48-50). The reaction temperature ranges from 180 to 270°C. (see col. 2, lines 6-8). Examples 1 and 2 disclose that the fatty acid can be C18, saturated or unsaturated and the polyhydric alcohol can be glycerol.

11. The difference between Applicant's claimed process and Voegeli is the ratio of acid to alcohol.

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12. However, when the general condition of a claim are disclosed in the prior art, it is not inventive to discover optimum of workable ranges by routine experimentation. In *re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). In this instance the Applicant is reacting 1 mole of acyl-containing compound (fatty acid) with 1 mole of glycerin (glycerol); while Voegeli is reacting 2 moles of fatty acid with 1 mole of glycerol. Further, Voegeli discloses that they are able to obtain the desired increase in monoglyceride by their choice of catalyst. Applicant is using the same type of metal catalyst as Voegeli, thus the change in molar ratios of the reactants can be deemed operator choice. Thus, these limitations are deemed to be obvious absent a showing of unexpected results.

A reference is good not only for what it teaches by direct anticipation but also for what one of ordinary skill in the art might reasonably infer from the teachings. (*In re Opprecht* 12 USPQ 2d 1235, 1236 (Fed Cir. 1989); *In re Bode* 193 USPQ 12 (CCPA 1976). In light of the forgoing discussion, the Examiner concludes that the subject matter defined by the instant claims would have been obvious within the meaning of 35 USC 103(a). From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

Furthermore, the prior art of Voegeli disclose process for making monoglyceride in high yield by reacting fatty acids with glycerol using metal catalyst selected from iron,

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cobalt and manganese. As such the difference between Voegeli and the claimed inventions is that it does not teach the invention with particularity so as to amount to anticipation (See M.P.E.P. § 2131: "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an ipsissimis verbis test, i.e., identity of terminology is not required. In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).).

Finally, based on the above, Voegeli teaches the elements of the claimed invention with sufficient guidance, particularity, and with a reasonable expectation of success, that the invention would be prima facie obvious to one of ordinary skill (the prior art reference teaches or suggests all the claim limitations with a reasonable expectation of success. See M.P.E.P. § 2143).

Allowable Subject Matter

13. Claim 5 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

14. Claims 9-13 are allowed.

15. The following is a statement of reasons for the indication of allowable subject matter: None of the prior art references teach or suggest a motivation for the reaction process where the amount of water contained in the reaction system is maintained at the claimed specific range in order to obtain the desired production levels.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to YATE' K. CUTLIFF whose telephone number is (571)272-9067. The examiner can normally be reached on M-TH 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel M. Sullivan can be reached on (571) 272 - 0779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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